

Attorney Docket No.: **MGU-0025**
Inventors: **Damha et al.**
Serial No.: **10/748,475**
Filing Date: **December 30, 2003**
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REMARKS

Claims 1-10 were pending in this application. No new matter has been added. Applicants are respectfully requesting reconsideration of the restriction requirement in view of the following remarks.

The claims of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 as follows:

Group I, claims 1-8, drawn to a composition for inhibiting the RNase H activity of a retroid virus reverse transcriptase; and

Group II, claims 9-10, drawn to a method of inhibiting the replication of a retroid virus and a method for preventing or treating a retroid virus infection comprising administering a composition which inhibits RNase H activity.

The Examiner acknowledges that Inventions I and II are related as product and process of use; however, they are suggested as being distinct because the product nucleotide of Group I can be used as a probe in *in situ* hybridization, which is different than the methods of inhibiting replication of a retroid virus and a method for preventing or treating a retroid virus infection comprising administering a composition which inhibits RNase H activity in cells or tissues, as present in Group II. The Examiner acknowledges that were Applicants to elect claims directed to the product, and the product claim were subsequently allowed, withdrawn process claims that depend from or otherwise include all limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP §821.04. Applicants are required to elect one of the Groups to be

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examined. Applicants respectfully disagree and traverses this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, and are patentable (novel and unobvious) over each other."

In contrast to the Examiner's suggestion, the unique double hairpin structure of oligonucleotides of Group I would find little use in *in situ* hybridization due to the significant amount of intramolecular hybridization. While the highly structured molecules of Group I claims are suitable for inhibiting the RNase H activity of retrovirus reverse transcriptase, these molecules would not be suitable for hybridization to endogenous mRNA for *in situ* detection. Thus, the oligonucleotides of Group I are not capable of separate use from the methods of Group II. Accordingly, Applicants respectfully request reconsideration and withdrawal of this restriction requirement and request that the claims of Groups I and II be searched and examined together in this application.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group I, claims 1-8, drawn to a composition for inhibiting the RNase H activity of a retrovirus

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virus reverse transcriptase, classified in class 536, subclass
24.5, with traverse.

Respectfully submitted,



Jane Massey Licata
Registration No. 32,257

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515